



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/830,195

04/22/2004

Marcia Buiser

01194-459001

7713

26161 7590 06/02/2010
FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

SCHLIENTZ, LEAH H

ART UNIT

PAPER NUMBER

1618

NOTIFICATION DATE

DELIVERY MODE

06/02/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/830,195	Applicant(s) BUISER ET AL.	
	Examiner Leah Schlientz	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11, 23-31, 49-53, 60, 62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 23-31, 49-53, 60, 62 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/26/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Receipt

Applicant's Response, filed 2/26/2010, in reply to the Office Action mailed 12/9/2009, is acknowledged and has been entered. Claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 are pending and are readable upon the elected invention and are examined herein on the merits for patentability.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive, for reasons set forth hereinbelow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen *et al.* (US 6,530,934) and Greene (US 2002/0177855), in view of Lanphere *et al.* (US 2003/0185895), for reasons set forth in the previous Office Action.

Applicant argues on pages 6-7 of the Response that the obviousness rejection is improper because the Examiner has not demonstrated that the asserted combination of Jacobsen, Greene and Lanphere would have enabled one skilled in the art to make the subject matter covered by the claims. Applicant asserts that applicable case law clearly states that "in order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus of method." Applicant argues that neither Jacobsen or Lanphere even disclose a process for joining particles, and the process disclosed by Greene would not work for the claimed subject matter, at least because the claimed subject matter requires the link and particles to be integrally formed of the same material.

This is not found to be persuasive. Jacobsen specifically teaches that the beads may be integrally formed of the material of the filament (column 4, line 24), and teaches polymer as a suitable material of both bead and filament, and also teaches porous particles. See also claim 25 of Jacobsen. Greene teaches that both the carrier and the micropellets may be made of PVA (see paragraphs 0093 and 0088). With regard to Applicant's argument that Jacobsen does not teach a process for joining particles, it is noted that a US patent is presumed to be operable/enabling per MPEP 2121. When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). In addition, under 35

Art Unit: 1618

U.S.C. 282 a patent shall be presumed valid (i.e. and thus is presumed to meet the enablement requirement). The Jacobsen patent discloses and claims that filament and bead are integrally formed. The instant claims include the limitation that the particles and link are integrally formed. Absent evidence to the contrary, it is presumed that one of ordinary skill would have been able to provide integrally formed polymeric particles/beads on a polymeric filament, as disclosed and claimed by Jacobsen. It is noted that the instant claims are product claims, not method of making claims.

Double Patenting

Claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 7,131,997; 7,449,236; 7,462,366; 7,588,780 and 7,611,542 in view of Jacobsen *et al.* (US 6,530,934) and Greene (US 2002/0177855), for reasons set forth in the previous Office Action.

Claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Application Serial No. 12/235,978, 12/236,051 and 10/651,475 in view of Jacobsen *et al.* (US 6,530,934) and Greene (US 2002/0177855), for reasons set forth in the previous Office Action.

Applicant argues on page 7 of the Response that in view of the above arguments, withdrawal of the rejection is requested.

This is not found to be persuasive, for reasons set forth above.

Conclusion

No claims are allowed at this time.

Although Applicant's arguments as set forth in the aforementioned Response have been fully considered, they are deemed unpersuasive. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is (571)272-9928. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday 9 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The

Art Unit: 1618

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

LHS